APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,129	11/25/2003	Hidehiko Fujiwara	040447-0255	4405

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EXAMINER
COLIN, CARL G

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/720,129	FUJIWARA ET AL.
	Examiner	Art Unit
	CARL COLIN	2433

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 June 2009</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-4 and 8-19</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-4 and 8-19</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 6/22/2009 has been entered.

Response to Arguments

2.   In communications filed on 6/22/2009, Applicant amends claims 14-16, and adds claim

19. The following claims 1-4 and 8-19 are presented for examination.

2.   Applicant's arguments, pages 6-9, filed on 6/22/2009 have been fully considered but they

are not fully persuasive. Regarding claim 1, Applicant argues that Smith does not disclose the

Delivery Server outside the firewall. Applicant's arguments are persuasive and a new ground of

rejection is made. However, it would require only routine skill in the art to implement the server

as part of the intranet. Regarding claims 14-16, Smith discloses judging whether or not device is

located within or outside firewall and whether devices can perform encryption (see column 1,

line 39 through column 2, line 12). With respect to claim 17, Smith discloses implementing a

delivery server as software which will make a virtual slave unit representing as a slave unit (see

column 4, lines 28-32).

Upon further consideration, the rejection of claims 1-4 and 8-19 is set forth below.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2003/0219127 to **Russ et al** in view of US Patent 6,487,278 to **Skladman et al**.

As per claim 1, **Russ et al** discloses a system for executing communications, the system comprises: **Russ et al** discloses DSCT may be acting as a proxy or gateway for the client-receiver 122 and providing access control (see page 5, paragraph 46 see also paragraph 71 and fig. 3) that meets the recitation of *at least one slave unit in an intranet protected by a firewall.* **Russ et al** discloses headend 102 and service providers (see paragraphs 32 and 35 and fig.1 that meets the recitation of *at least one slave unit outside the firewall.* **Russ et al** discloses *an agency communication section* (i.e. DSCT) *equipped to the intranet* (see figure 1) *for*

executing encryption or decryption by agency (see page 5, paragraph 46) *for a slave unit* (client-receiver 122) *having no mechanism* (no secure element) *for encryption in the intranet* (see page 15, paragraph 145), wherein the system executes communications between a slave unit (client-receiver 122) in the intranet protected by the firewall (DSCT has firewall capability) and another slave unit (headend 102 and service providers) located outside the firewall through the Internet (see paragraph 132). As interpreted by Examiner, the DSCT performs role of filtering traffic from and to the client-receiver which is broadly and reasonably interpreted as a firewall. **Skladman et al** in an analogous art teaches a converter having a function of a slave unit inside an intranet protected by a firewall with a function of converting voice and data formats to go beyond the firewall and a server outside the firewall wherein the system executes communications between a slave unit in an intranet protected by a firewall and another slave unit located outside the firewall through the Internet (see column 4, lines 1-20 and abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to establish a system protected by firewall so as to regulate traffic coming in and out of the firewall as suggested by **Skladman et al** (see column 8, lines 33-55).

As per claim 2, the references as combined above disclose the claimed system of claim 1. **Russ et al** discloses DSCT may be acting as a proxy for the client-receiver and access control (see page 5, paragraph 46 see also paragraph 71 and fig. 3) that meets the recitation of intranet with a firewall. **Russ et al** further discloses wherein said agency communication section (i.e. DSCT) executes the communications without encryption, when an access is made from a slave

unit which is located outside the firewall and is not adapted to encryption (see page 10,

paragraph 92).

4.   **Claims 3-4 and 11-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over US

Patent Publication 2003/0219127 to **Russ et al** in view of US Patent 6,487,278 to **Skladman et**

al as applied to claims 1-2 and further in view of US Patent 6,502,191 to **Smith et al**.

        As per claims 3-4, **Russ et al** substantially discloses the DSCT is adapted to determine

whether communication should be encrypted or not and wherein said agency communication

section executes communications without encryption or inhibits communications, when an

access is made from a slave unit inside the firewall to a terminal (head end) which is located

outside the firewall (see page 11, paragraph 103 and page 5, paragraph 46, sentence before last).

Russ et al is silent about the terminal outside the firewall is not adapted to encryption, but

discloses in an embodiment that encryption is not necessary for terminal inside the firewall since

it is not adapted to encryption. Therefore, it would have only required routine skill in the art and

design choice to have the client-receiver (i.e. laptop) communicating with a terminal not adapted

to encryption because **Russ et al** suggests different non-limiting factors for determining whether

encryption and decryption should be carried by DSCT and this will not depart from the spirit and

scope of the invention disclosed by Russ et al (see page 11, paragraph 107 and page 15,

paragraph 145). **Smith et al** further teaches a proxy server that executes communications without

encryption (such as HTTP) or inhibits communications when an access is made from a computer

in the Intranet protecting by a firewall to a receiving device (other internet server, fax machine,

printer...) which is located outside the firewall and is not adapted for encryption (see column 1, lines 58-63 and column 2, lines 5-35).   Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to establish a system protected by firewall so as to regulate traffic coming in and out of the firewall as suggested by **Smith et al** (see column 2, lines 5-35).

As per claims 11-13, the references as combined above disclose wherein the communications between a slave unit inside the intranet and a slave unit on the Internet are executed through an HTTP port of the firewall (see **Smith et al,** column 2, lines 25-35). Therefore, claims 11-13 are also rejected on the same rationale as the rejection of claims 3-4 above.

As per claims 14-16, **Russ et al** discloses wherein a slave unit having a mechanism for encryption is used, and said slave unit has means for judging whether said slave unit is located inside or outside the firewall, said slave unit executing encryption if it is judged by said means that said slave unit is located outside the firewall and has a capability for sending and receiving encrypted data or stopping the encryption function if it is judged by said means that said slave unit is located inside the firewall (see page 9-10, paragraphs 90-92) (see also **Smith et al** column 1, lines 58-63).

As per claim 17, **Smith et al** discloses a send client that represents a slave unit in the intranet communicating with the delivery server (as an agency communication) as if it is as

another slave unit which implies that the slave unit being included in the agency. **Smith et al**

discloses implementing a delivery server as software which will make a virtual slave unit

representing as a slave unit (see column 4, lines 28-32). As interpreted by Examiner, **Russ** also

discloses a proxy server as an agency communication communicating with the client and the

proxy as if it is another slave unit which implies that the slave unit being included in the agency

(see column 6, lines 40-43).

As per claim 18, **Smith et al** discloses encrypted communications is possible between

servers on each side of the firewall (see column 1, lines 39-63) that meets the recitation of

wherein the communications between the slave unit in the intranet protected by the firewall and

the slave unit located outside the firewall through the Internet is a two-way communication in

which voice and data is encrypted in both directions of the two-way communication.

As per claim 19, **Smith et al** discloses encrypted communications is possible between

servers on each side of the firewall to reach a fax or printer not capable of sending or receiving

encrypted data; and further discloses to make it possible all data passing through the firewall are

encrypted and encapsulated by a firewall server before sending outside the firewall and are

decrypted by a firewall server before sending to a remote device such as fax or printer or to an

intranet system, it is understood that one of ordinary skill in the art would be able to use Smith to

replicate the same features described at the receiving side to the sending side when the sending

device is a fax (not capable of sending or receiving encrypted data) (see column 1, lines 39-63)

which meets the recitation of wherein when the at least one slave unit is determined to not be

capable of sending and receiving encrypted data, all communications with another slave unit

located outside of the firewall passes through said agency communication section, in which said

agency communication section encrypts all data sent from the at least one slave unit before

sending it outside the firewall to be received by the another slave unit and in which said agency

communication section decrypts all data received from the another slave unit and destined for the

at least one slave unit before providing the decrypted data to the at least one slave unit.

5.   **Claims 8-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

Publication 2003/0219127 to **Russ et al** in view of US Patent 6,487,278 to **Skladman et al** as

applied to claims 1-2 and further in view of US Patent 6,813,264 to **Vassilovski**.

        As per claims 8-9, **Russ et al** substantially discloses wherein said agency communication

section analyzes encrypted data, and executes the communications to a Web server or a slave

unit in the intranet on the basis of the judgment result (see page 10, paragraph 92). **Russ et al**

does not explicitly disclose judging whether the encrypted data indicates a Web access or

encrypted private branch IP telephone communication, but suggests any type of communication

protocol (see page 2, paragraph 24). **Vassilovski** in an analogous art teaches determining

whether encrypted data should be routed to VOIP or PSTN and executes the communications to

a Web server or a slave unit on the basis of the judgment result that meets the recitation of

wherein said agency communication section analyzes the encrypted data to judge whether the

encrypted data indicates a Web access or encrypted private branch IP telephone communication,

and executes the communications to a Web server or a slave unit in the intranet on the basis of

the judgment result (see abstract and figure 2). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the system as combined

above to include judging for data such as web access or IP telephone communication and

executes the communications to a Web server or a slave unit in the intranet on the basis of the

judgment result because it would direct communications to the right service according to user

registration and entitlement to the service as suggested by **Vassilovski** (see column 2, line 35

through column 3, line 23).

6.   **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

Publication 2003/0219127 to **Russ et al** in view of US Patent 6,487,278 to **Skladman et al** in

view of US Patent 6,502,191 to **Smith et al** as applied to claim 3 and further in view of US

Patent 6,813,264 to **Vassilovski**.

        As per claim 10, **Russ et al** substantially discloses wherein said agency communication

section analyzes encrypted data, and executes the communications to a Web server or a slave

unit in the intranet on the basis of the judgment result (see page 10, paragraph 92). **Russ et al**

does not explicitly disclose judging whether the encrypted data indicates a Web access or

encrypted private branch IP telephone communication, but suggests any type of communication

protocol (see page 2, paragraph 24). **Vassilovski** in an analogous art teaches determining

whether encrypted data should be routed to VOIP or PSTN and executes the communications to

a Web server or a slave unit on the basis of the judgment result that meets the recitation of

wherein said agency communication section analyzes the encrypted data to judge whether the

encrypted data indicates a Web access or encrypted private branch IP telephone communication, and executes the communications to a Web server or a slave unit in the intranet on the basis of the judgment result (see abstract and figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system as combined above to include judging for data such as web access or IP telephone communication and executes the communications to a Web server or a slave unit in the intranet on the basis of the judgment result because it would direct communications to the right service according to user registration and entitlement to the service as suggested by **Vassilovski** (see column 2, line 35 through column 3, line 23).

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL COLIN whose telephone number is (571)272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl Colin/
Primary Examiner, Art Unit 2433
August 29, 2009